

**REMARKS**

The Office Action indicated that the subject matter of Claims 13 and 16 would be allowed if rewritten in independent form. Claim 16 has been rewritten verbatim in independent form and is, accordingly, believed allowable. Claim 13 has also been redrafted in independent form to incorporate independent Claim 2 and dependent Claim 11 with the allowed subject matter of Claim 13.

Claim 9 has been cancelled to moot the 35 U.S.C. §101 issue.

The Office Action raised an issue under 35 U.S.C. §112, first paragraph, as to the written description relative to Claims 12 and 15. Applicant respectfully traverses this rejection, and we direct the Examiner to the teachings in respective Figures 7 and 8 and the disclosure on Page 29, Lines 5-14. The same subject matter can be found in the printed publication US 2005/0225651, at Paragraphs 104 and 105.

As can be appreciated, the present invention is addressing the economic realities of photographed image display devices, for example on mobile cell phones, which are relatively compact and inexpensive. As presumably the Examiner is aware, major service providers will literally give the phones away to capture subscriber contacts for service and this also applies to other handheld personal digital assistants (PDA's) that also earn subscriber fees. In such an environment both the size and particularly the cost of the device is an important and technological limitation that is addressed by our present invention.

Our present inventors have identified this unique problem and provided a solution not found nor suggested in the prior art of record.

The mere formulation of a problem is often far more essential than its solution, which may be merely a matter of mathematical or experimental skill. To raise new questions, new possibilities, to regard old problems

from a new angle requires creative imagination and makes real advances in science.

Albert Einstein

The advantage of one invention is, accordingly, described on Page 29, Lines 16-21 as follows:

#### Industrial Applicability

A photographed image display device and a photographed image display method according to the present invention can contribute to miniaturize a mobile communications terminal with a photographing function and to reduce a manufacturing cost of such a terminal.

Our invention, as recited in Claim. 2 of the present application, is characterized in a photographed image display device comprising: a first LCD module and a second LCD module which each include a graphic memory operable to store image data and an LCD operable to display an image based on the image data stored in the graphic memory; a photographing unit operable to form an optical image of an object, convert the formed optical image into image data, and output the image data sequentially; a first transfer unit operable to receive the image data output from the photographing unit and transfer the image data to the graphic memory in the first LCD module; a storage medium prestoring frame image data; a judging unit operable to judge whether the transfer of the image data from the first transfer unit to the graphic memory in the first LCD module has been completed; and a second transfer unit operable to, when the transfer, has been completed, read the image data from the graphic memory in the first LCD module, combine the read image data and the frame image data so as to generate composite image data, and transfer the composite image data to the graphic memory in the second LCD module.

As mentioned above, the graphic memory of the first LCD module functions as a memory for temporarily storing image data which is sequentially output from the photographing

unit and then displayed in the LCD, which arguably is a conventional technique. However, in addition, the graphic memory also functions as a buffer memory for directly reading the image data from the graphic memory and combining the read image data and the frame image data, which is not a conventional technique.

In our invention, there is no need to provide an additional buffer memory, when image composition is performed, to temporarily store image data for image composition. An existing LCD graphic memory doubles as a buffer memory, and thus, the invention of the present application yields a unique, advantageous effect in which a composite image based on the composite image data can be displayed on the LCD using a simple and inexpensive device structure.

The *Lanier* reference discloses two LCD modules each having a graphic memory in the graphic communication system shown in FIG. 5, and image data asserted to be transferred between these LCD modules under the control of a personal computer 93. However, it is not specifically described in *Lanier* how image data is transferred from one of the LCD modules to the other LCD module.

Moreover, as explained above, it is a conventionally known technique that the graphic memory functions as a memory for temporarily storing the image data which is displayed in the LCD. A person of ordinary skill in this field and using common sense would presume that this function is performed in *Lanier*. However, it is the technique disclosed by the invention recited in Claim 2 that, for the first time, teaches the LCD graphic memory also functions as a buffer memory for directly reading the image data from the graphic memory and combining the read image data and the frame image data. Additionally, this technique cannot be derived from the structure shown in Figure 5 of *Lanier*.

In addition, *Ohmura et al.* neither discloses nor suggests the structure of the invention recited in Claim 2, i.e., a structure which uses an existing graphic memory also as a buffer memory.

Accordingly, it is not possible to realize the advantageous effect unique to the invention recited in Claim 2 based on *Lanier* or *Ohmura et al.*, or any combination of these references. Thus, the invention recited in Claim 2 cannot be conceived or based on *Lanier* and *Ohmura et al.*, and involves novelty and an inventive step over these cited reference.

The inventions recited in Claims 3, 5, 7, 11, and 14 also have a structure corresponding to the structure of the invention recited in Claim 2. Accordingly, these claims also involve novelty and an inventive step over *Lanier* and *Ohmura et al.*, as in the case of the invention recited in Claim 2.

As can be appreciated, the *Lanier* reference specifically taught a video camera connected to a computer as shown in Figure 1 for receiving specific positional signals from a electromagnetic field generator 6 that are received by a sensor 8 mounted on the headphones of a user. Based on this arrangement an animated character or Avatar could be created and a user's face could be superimposed within the environment of the animated graphic image. A person of ordinary skill in the field in reviewing the *Lanier* reference, would conclude from each of the embodiments, that he/she is taught to identify a location and position of the human face to permit the computer system to superimpose a face within an Avatar background.

There is no teaching of miniaturization nor removal of unnecessary buffer memories since the problem recognized and resolved by our present invention is never contemplated nor addressed in the *Lanier* reference.

As we have pointed out before, the use of a pair of LCD screens in a cellular telephone, as taught in the *Ohmura et al.* reference, is for the purposes of dedicating one LCD screen to a relatively inexpensive black and white unit, for only displaying characters and communication information. The second LCD screen was a more expensive multicolored display for disclosing an image such as a photograph. Again, a person of ordinary skill utilizing common sense would appreciate from Paragraph 0065, that the respective LCD 331 and the LCD 332 were separately controlled and could be turned off to save power and operated independently.

Our present invention is specifically directed to permitting LCD modules to interact pursuant to control signals in a unique manner to eliminate the conventional cost of a buffer memory.

As noted in *ex parte Rinkevich et al.*, Appeal 207-1317, May 29, 2007 at Page 9:

We note that the U.S. Supreme Court recently reaffirmed that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautioned of argument reliant upon *ex post* reasoning.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. See also *Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474. Nevertheless, in *KSR* the Supreme Court also qualified the issue of hindsight by stating that “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. In the instant case, we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill. Therefore, we agree with Appellants that the Examiner has impermissibly used the instant claims as a guide or roadmap in formulating the rejection.

It is respectfully submitted that the guidelines required for utilizing the *KSR* case under 35 U.S.C. §103 have been unintentionally violated by an *ex post facto* reasoning in hindsight from our present disclosure. It is submitted that a person of ordinary skill in the art, utilizing common sense at the time of our invention, would not have reasonably looked to the *Janier*

reference for any combination with the *Ohmura et al.* reference, other than by using our present claims as a guide or roadmap in formulating the rejection.

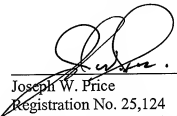
Accordingly, it is believed that not only the subject matter of independently drafted Claims 13 and 16 are allowable, but it is respectfully requested that the other rejected claims be reconsidered in view of the above comments.

It is believed that the case is now in condition for allowance and early notification of the same is requested.

If the Examiner believes a telephone interview will help further the prosecution of the case, the undersigned attorney can be contacted at the listed phone number.

Very truly yours,

**SNELL & WILMER L.L.P.**



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